

OCT 09 2006

Application Serial No. 10/811,768
Reply to Office Action of September 11, 2006

PATENT
Docket No. CU-3664

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application: Kiyoshi OOI et al.] GRP ART UNIT: 2891
Serial No: 10/811,768] Ex.: Wilson, Christian D.
Filed: March 29, 2004]
For: SEMICONDUCTOR DEVICE SUBSTRATE, SEMICONDUCTOR DEVICE,
AND MANUFACTURING METHOD THEREOF

Certification under 37 C.F.R. §1.8(a)

The USPTO Central Fax No. (571) 273-8300

Date of Fax Transmittal: October 9, 2006.

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted to the United States Patent and Trademark Office to the fax number and on the date indicated above.


Paul Cronin

The Commissioner for Patents
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RESPONSE TO RESTRICTION REQUIREMENT

In the Office Action dated September 11, 2006, setting a 1-month shortened statutory period for a reply ending on October 11, 2006, the pending claims 10-23 were restricted as follows:

- I. Species 1, **claims 10-13**, pertaining to a device comprising a bump to be connectable to any externally provided semiconductor element;
- II. Species 2, **claims 14-17**, pertaining to a device comprising a semiconductor element mounted on the semiconductor device substrate and electrically connected to the bump of the electronic component;
- III. Species 3, **claims 18-20**, pertaining to a device wherein the substrate layer has a depressed portion between the opening and the electronic component to expose the bump; and
- IV. Species 4, **claims 21-23**, pertaining to a device wherein the substrate

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layer has a depressed portion between the opening and the electronic component to expose the bump and a semiconductor element mounted on the device substrate and connected to the bump.

Applicants hereby elect Species I, **Claims 10-13**, with traverse for the reasons below.

Applicants retain the right to present the non-elected in a divisional application.

Applicants respectfully request the the restriction requirement be withdrawn on grounds that the search and examination of Species I, **Claims 10-13** in conjunction with the search and examination of the rest of the Claims 14-23 are not unduly burdensome.

MPEP §803 provides:

"If the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to independent or distinct claims."

In particular, Applicants believe that each element recited in each set of claims does not substantially increase the search and examination requirement of the entire application.

Applicants respectfully point out that the examination on the **merits** of all pending Claims 10-23 have already been made as it is reflected in the first Office Action mailed December 21, 2006, and to which Applicants have filed an Amendment Under 37 CFR 1.111 on March 15, 2006.

After a first action on the merits, MPEP §811, as understood, requires showing of a serious burden on the Examiner for continued examination on the merits if the restriction requirement is not made:

"Before making a restriction requirement after the first action on the merits, the Examiner **will** consider whether there will be a serious burden if restriction requirement is not required." (MPEP §811)

Even though claims were amended in the last filed Amendment, the claimed

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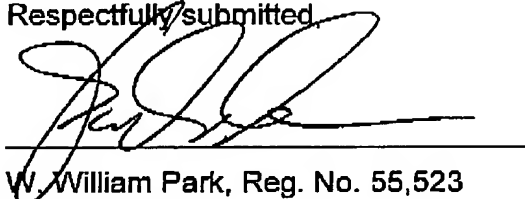
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subject matter of the amended claims are **not** believed to differ in terms of distinctiveness when compared to the subject matter of the claim before it was amended. Thus, the current issue here is **not** whether Species 1-4 as indicated in the current office action are distinct from each other, because the current restriction requirement is **not** made in the first action. The issue here (according to MPEP §811) is whether there is a serious burden presented to the examiner to examine the subject matter of claims 10-23 (as amended).

No explanation of such a serious burden for continued examination on the merits is provided in the current Office Action, as the current restriction requirement is based solely on the distinctness ground—between the method claims and product claims.

For the reasons above, Applicants respectfully request withdrawal of the current restriction requirement and prompt examination of all claims 10-23 (while confirming the election with traverse of Species I, **Claims 10-13**).

Respectfully submitted,



Dated: October 6, 2006

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